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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,366	04/20/2004	Johan Skjellerup	1.156-A.04	4881

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EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT PAPER NUMBER

3676

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,366

Applicant(s)

SKJELLERUP, JOHAN

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,9,10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9,10,12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/20/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings were received on 12/20/04. These drawings are approved.

Double Patenting

2. The Terminal Disclaimer filed 12/20/04 has been approved.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,3-5,9,10,12-22 are rejected under 35 U.S.C. 103(a) as being clearly anticipated by Hogan 4,944,075 in view of Weber 5,613,384. Hogan teaches a lock housing assembly comprising a connector 14, multiple indicator ampules 20 triangularly disposed on a mounting retainer 22, and a shield assembly 72 for shielding the magnetic locking means 29/16. It is noted that the side portion of housing 12 is upwardly sloped toward the connector 14 so as to direct an unauthorized object into the ampules. Hogan fails to teach the use of a "heat-resistant" shield. Weber et al teach a security device comprising a shield assembly made from a heat resistant material (col. 4, lines 16-28). It would have been obvious to one of ordinary skill in the art to provide a heat-resistant material for the shield assembly 72 of Hogan as taught by Weber et al

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since such a modification would serve to enhance the security of the device and prevent tampering of the lock assembly. It is further noted with respect to claims 19-22 especially, that the shape of an element is considered an obvious matter of design choice and since the Hogan reference teaches a sloped or curved portion as discussed above, to modify Hogan to provide a substantially curved or convex shape would have been considered an obvious matter of design choice.

5. Claims 1,3-5,9,10,12-22 are further rejected under 35 U.S.C. 103(a) as being clearly anticipated by Thurmond et al 5,347,262 in view of Weber 5,613,384. Thurmond et al teach a lock housing assembly comprising a connector 14, multiple indicator ampules 20 triangularly disposed on a mounting retainer 24, and a shield assembly 82 for shielding the magnetic locking means 22/16. It is noted that the upper portion of cover 58 is upwardly sloped (at 61) toward the connector 14 so as to direct an unauthorized object into the ampules and away from perpendicular access to the connector 14 and furthermore, is extended into the space created by the connector housing 10. Thurmond et al fail to teach the use of a "heat-resistant" shield. Weber et al teach a security device comprising a shield assembly made from a heat resistant material (col. 4, lines 16-28). It would have been obvious to one of ordinary skill in the art to provide a heat-resistant material for the shield assembly 72 of 82 of Thurmond et al as taught by Weber et al since such a modification would serve to enhance the security of the device and prevent tampering of the lock assembly. It is further noted with respect to claims 19-22 especially, that the shape of an element is considered an obvious matter of design choice and since the Thurmond reference teaches a sloped or

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curved portion as discussed above, to modify Thurmond to provide a substantially curved or convex shape would have been considered an obvious matter of design choice.

Response to Arguments

6. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. In response to Applicant's amendment, the claims are now rejected over Hogan or Thurmond and Weber as previously discussed.

Applicant's arguments regarding the curved convex shape of the interior surface are not persuasive. It is well known in the lock art to provide curved or sloped surfaces on lock elements to prevent prying apart or tampering therewith. Absent any specific criticality shown by Applicant for the majority of the surface being curved or convex, it would have been considered an obvious matter of design choice to change the shape of the surface of either Hoagn or Thurmond.

Applicant's arguments regarding the heat shield on pages 25-26 of the remarks are not persuasive. It is noted that if Hogan and Thurmond provided a teaching of a heat shield, the rejection would be based on 35 USC 102, not 103. It is precisely the teaching of Weber which would have made it obvious to one of ordinary skill in the art at the time of this invention (not at the time of the Hogan and Thurmond inventions) to provide the well known security tag assembly of either Hogan or Thurmond with a heat shield as taught by Weber to prevent tampering. In response to applicant's argument

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that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Weber clearly provides a teaching. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, Applicant's contention that Weber is non-analogous art on page 26 is also not persuasive. Weber teaches the use of a heat shield on a lock assembly to prevent tampering and unauthorized release of the lock. The security tag of the instant invention is a lock assembly which would inherently desire anti-tampering features to prevent unauthorized release of the lock connection. In response to applicant's argument that Weber is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied

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upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Weber is both in the field of applicant's endeavor and pertinent to the particular problem concerned.

Accordingly, claims 1,3-5,9,10,12-22 stand rejected.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 703-308-0825. The examiner can normally be reached on M-Th 8:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb